

REMARKS

Status of the Claims

Claims 1-12 and 19-35 are pending

Claims 1-12 and 19-22 currently stand rejected.

I. Amendments

Claims 1-6 and 19, and claims 7-12 and 20-22 through their dependency have been amended to more particularly point out what the applicant considers their invention. The amendments to claims 1-3 and 19 are supported throughout the specification with specific example found on page 3 lines 18-20. Claims 4-6 have been amended to define ``high'' in high specific gravity filler and support is found throughout the specification and specifically on page 7, line 5.

New claims 25-35 are supported throughout the specification and are specifically found on page 9. The claims contain no new matter and are allowable as drafted.

II. Claim Rejections under 35 U.S.C. 112

Claims 4-6 are rejected under 35 U.S.C. 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The applicants respectfully disagree with the assertion that ``high'' is indefinite because it is a term that is clearly defined by the specification and not a relative term. In an effort to move the application forward applicants amend claims 4-6 to define ``high'' in ``high specific

gravity filler'' as ``having a specific gravity greater than 5.6''.

The applicants respectfully request removal of the rejection in light of the amendments and arguments provided.

III. Claim rejections under 35 U.S.C. 102

Claims 1-6 stand rejected under 35 U.S.C. 102(b) as being anticipated by Kakiuchi et al. (USPN 5,846,142) for disclosing a thread winding layer disposed over a center, wherein said thread has a specific gravity greater than 0.94. Applicants respond through amendment of claims 1-3 and 4-6 through their dependency. Claims 1-6 have been amended to claim a thread winding layer having a specific gravity greater than 1.2. Kakiuchi et al. '142 specifically teaches away from the amended claims 1-6 when it states ``[t]he wound golf ball of the invention **must** meet requirement (2) that the thread rubber layer 2 has a specific gravity of 0.93 to 1.05'' (See Column 2, lines 54-56).

The claim after amendment is not anticipated by Kakiuchi because it fails to teach each and every limitation. The applicants respectfully request reconsideration and removal of the 102 rejection. The applicants respectfully request allowance of all claims.

IV. Claim rejections under 35 U.S.C. 103

Claims 7-12 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kakiuchi et al (USPN 5,846,142) in view

of Maruko (USPN 6,135,899). The applicants respectfully traverse this obviousness rejection as being incorrect for failing to accurately describe the teaching of Maruko in combination with Kakiuchi. The rejection is moot in light of the amendment of claims 1-6, which amends claims 7-12. Further the amendment of claim 19 and claims 20-22 through dependency makes the rejection moot.

The applicants respectfully traverse the rejection regardless of it being moot to correct the examiner's assertion of the teaching of Maruko '899. Maruko specifically teaches that *"[t]he density of the rubber thread layer is preferably from 0.65 to 0.85 g/cm³ , and especially 0.7 to 0.8 g/cm³."* (See Maruko column 4, lines 40-42). This thread layer has a specific gravity that is below a specific gravity of 0.94 as originally discussed. Additionally Maruko goes on further to teach that the rubber thread used has a specific gravity of 0.93. (See Table 3) Maruko teaches the density of the "layer" using the 0.93 thread wound around the core, the "layer" has a specific gravity **BELOW** that taught of our layer and of our specific thread.

Maruko **does not teach** the use of high specific gravity fillers in a thread winding layer or the use of high specific gravity windings, as the examiner implies when in the office action states *"a high specific gravity filler in a rubber composition layer of golf balls (cols. 2-3, lines 57+ and 1-9 respectively. Maruko further teaches wrapping at least one*

thread around a center forming a core and disposing a cover upon a core (col. 4, lines 37-40).'' This specifically teaches the construction of a two-piece center having threads wound upon the center and not a high specific gravity thread winding layer. Maruko specifically teaches the characteristics of the thread winding layer in its specification and it is opposite the teachings that are purported in the rejection.

The examiner's rejection statement that "[t]herfore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention, is factually incorrect, misleading and an incorrect application of the law. This first uses hindsight reasoning and the applicant's specification's own teaching to produce the obviousness rejection. Further an obvious to try standard which has been specifically rejected by the courts as improper and is clearly used by the statement that "in view of Maruko, to use Tungsten as a high specific gravity filler in the thread layer of Kakiuchi for the purpose of achieving the desired specific gravity of a thread layer with a minimal amount of filler, especially since Kakiuchi states that the inorganic filler used in his thread layer is not critical and may be chosen from a variety of commonly used fillers (col. 2, lines 45-48).''

The Federal Circuit has stated that "[t]he test for obviousness is not whether the features of one reference may be bodily incorporated into another reference. . . . Rather, we look

to see whether combined teachings render the claimed subject matter obvious.'" See In re Wood, 599 F.2d 1032, 202 USPQ 171, 174 (C.C.P.A. 1979) (emphasis added) (citing In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549-50 (C.C.P.A. 1969)).

As discussed above Maruko specifically teaches the specific gravity of its thread winding layer. The reference to column 3, lines 1-9 is a clear mischaracterization of Maruko's teachings which are describing adding fillers to the center. Column 6 of Maruko teaches a rubber thread having a specific gravity of 0.93 but it does not teach the addition of heavy fillers.

As clearly presented the teachings of the combination do not lead to the production of the instant invention. Maruko only teaches the use of high specific gravity fillers.

Kakiuchi et al teaches the use of addition of only low gravity fillers to the threads. Kakaiuchi teaches against using higher gravity threads when it states *"If the thread rubber layer's specific gravity is more than 1.05, the resulting ball is reduced in restitution and rubber thread can be frequently snapped during winding"* (See column 2, lines 58-62). This is because using the disclosed low specific gravity fillers taught the rubber volume is reduced making the threads unusable. This is teaching away from using higher gravity threads and the solution produced by the instant invention is ONLY taught by the applicants specification. Using the teaching of our specification is improper and thus the combination fails to form the instant invention either singly or in combination.

V. Double Patenting Rejection

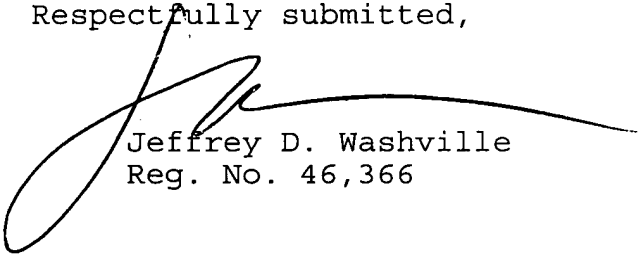
Claims 1-12 and 19-22 are rejected under obviousness type double patenting over claims 1-14 of US Patent No. 6,270,428. The applicant respectfully request reconsideration and removal of this rejection because the `428 patent is directed toward the use of heavy fillers in the core or center of a thread wound ball and NOT in the threads themselves. The inventions are not obvious or related other than being directed towards a thread wound ball. The claims of the `428 patent and the instant inventions specification are not obvious since they are directed toward completely different inventions. Therefore the rejection is respectfully requested to be reconsidered.

VI. Conclusion

The applicants respectfully request removal of all rejections and allowance of all claims including newly added claims 25-35 which are clearly patentable over the prior art.

Please feel free to call collect with any questions regarding this submission or any matters relating to this application.

Respectfully submitted,



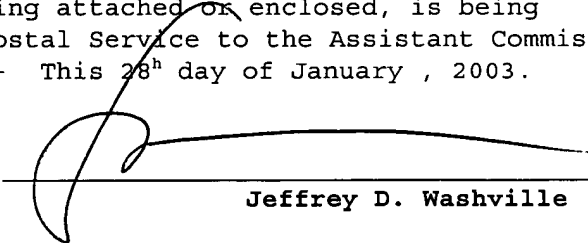
Jeffrey D. Washville
Reg. No. 46,366

Date: January 28, 2003

440 Commercial Street
Boston, MA 02109
Tel.: (617) 227-0700
FAX: (617) 723-4609

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The undersigned hereby certifies that this paper along with any paper or document referred to therein as being attached or enclosed, is being deposited with the United States Postal Service to the Assistant Commissioner for Patents, Washington D.C. 20231- This 28th day of January , 2003.



Jeffrey D. Washville